

REMARKS

By this Amendment, Applicants amend claims 7 and 11, cancel claims 4-6 without prejudice or disclaimer, and add new claims 12-14. Accordingly, claims 1-14 are now pending in this application.

In the Office Action,¹ the Examiner objected to claims 4 and 5 under 35 U.S.C. § 132(a), alleging that the amendment of April 6, 2006, introduced new matter; objected to the specification as failing to provide support for the subject matter of claims 4 and 5; objected to claim 11 due to an informality; rejected claim 6 under 35 U.S.C. § 112, second paragraph; rejected claims 1, 3-9, and 11 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff et al. (U.S. Patent No. 6,385,591) in view of Sim (KR2000030358A); and rejected claims 2 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Sim and in further view of Golden et al. (U.S. Patent No. 5,781,648).

Although Applicants respectfully traverse the objection to claims 4 and 5 under 35 U.S.C. § 132(a); the objection to the specification as failing to provide support for the subject matter of claims 4 and 5; and the rejection of claim 6 under 35 U.S.C. § 112, second paragraph, Applicants have canceled claims 4, 5, and 6, thus rendering these objections and the rejection moot. Furthermore, Applicant has amended claim 11 so that the claim depends from claim 9. Accordingly, Applicant respectfully requests that the Examiner withdraw the objection to claim 11.

¹ The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

I. REJECTION OF CLAIMS 1, 3-9, AND 11 UNDER § 103(a)

Applicants respectfully traverse the rejection of claims 1, 3-9, and 11 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Sim. Applicants note that with respect to canceled claims 4-6, the rejection is now moot. Furthermore, with regard to Sim, Applicants note that Examiner's citations in the Office Action and Applicants' citations in this paper are with respect to WO 01/63507 A1, an English language version of Sim.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2142, 8th Ed., Rev. 4 (October 2005), p. 2100-134. In this application, a *prima facie* case of obviousness has not been established for at least the reason that the applied references, taken alone or in combination, do not teach or suggest all of the elements of the claims.

Independent claim 1 recites a method including, among other steps, "in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer an identifier associated with a second user computer" and "in response to the receipt of the identifier, transmitting a coupon to the

second computer." Mankoff and Sim, whether taken individually or in combination, do not teach at least these elements of independent claim 1.

By contrast, in the Mankoff system, a coupon is transmitted from a server directly to either a personal computer or a PDA (Fig. 1), a PDA is synchronized with a personal computer to download coupon offers to the PDA (Fig. 2), or a coupon is directly downloaded to a PDA from a retail site web server (Fig. 3). Accordingly, Mankoff does not disclose or suggest that "in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer an identifier associated with a second user computer" and "in response to the receipt of the identifier, transmitting a coupon to the second computer," as required by independent claim 1 (emphasis added).

Moreover, Sim does not compensate for the deficiencies of Mankoff. Instead, Sim discloses "a coupon serving system [which] allows a customer to buy commodities or use services through the use of coupons received in his or her wireless communication terminal equipment." See page 3. In particular, in the Sim system, data transmitting server 7 includes a coupon data transmission program that transmits coupon data to wireless communication terminal equipments 2. See page 4. Thus, Sim teaches directly transmitting a coupon from a server to a wireless device, but does not teach or suggest "receiving from the user through the first user computer an identifier associated with a second user computer" and "in response to the receipt of the identifier, transmitting a coupon to the second computer," as required by independent claim 1 (emphasis added). Therefore, Sim does not cure the deficiencies Mankoff.

For at least the above reasons, Mankoff and Sim, individually or in combination, do not teach or suggest each and every element of independent claim 1. Furthermore, independent claim 9, while of a different scope from claim 1, includes recitations of a similar scope as claim 1. Accordingly, a *prima facie* case of obviousness has not been established with respect to independent claims 1 and 9, and dependent claims 3, 7, 8, and 11 are allowable at least due to their dependence from allowable independent claims 1 and 9. Therefore, the Examiner should withdraw the rejection of claims 1, 3, 7-9, and 11 under 35 U.S.C. § 103(a).

II. REJECTION OF CLAIMS 2 AND 10

Applicants respectfully traverse the rejection of claims 2 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Sim and in further view of Golden.

As discussed above, Mankoff and Sim, individually or in combination, do not teach or suggest “in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer an identifier associated with a second user computer” and “in response to the receipt of the identifier, transmitting a coupon to the second computer,” as required by independent claims 1 and 9, from which claims 2 and 10 respectively depend. In the Office Action, the Examiner contends Golden teaches “a feature whereby the user may download only a certain number of coupons.” See Office Action at page 6. Even if the Examiner’s characterization of Golden is correct, which Applicants do not concede, Golden does not compensate for the deficiencies of Mankoff and Sim already discussed. That is,

Golden also does not teach or suggest that “in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer an identifier associated with a second user computer” and “in response to the receipt of the identifier, transmitting a coupon to the second computer,” as required by independent claims 1 and 9.

Claims 2 and 10 depend from independent claims 1 and 9, respectively. Accordingly, even if Golden were combined with Mankoff and Sim as the Examiner proposed, the combination still does not teach or suggest all elements recited in independent claims 1 and 9, and required by dependent claims 2 and 10. Accordingly, Mankoff, Sim, and Golden, taken individually or in combination, do not teach or suggest all of the elements required by dependent claims 2 and 10. Therefore, the Examiner should withdraw the rejection of claims 2 and 10 under 35 U.S.C. § 103(a).

III. NEW CLAIMS 12-14

New independent claim 12, while of a different scope from allowable independent claims 1 and 9, includes recitations that are not taught or suggested by the applied references whether taken individually or in combination. That is, Mankoff, Sim, and Golden do not teach or suggest system including “a web server that transmits a banner advertisement related to a purchasing incentive to a first user computer over a network and receives an identifier that is associated with a second user computer from a user of the first user computer” and “an ad server that receives the identifier from the web server and transmits a coupon to the second computer.” Furthermore, new claims 13

and 14 depend from allowable independent claim 12. Therefore, for at least the reasons given above, the Examiner should allow new claims 12-14.

CONCLUSION

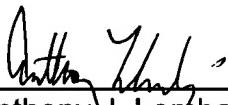
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 
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